

### **REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. This Amendment should be entered under Rule 116 because it places this application in condition for allowance.

Claims 1-6 remain pending in the application. By this Amendment, the Abstract is replaced, Fig. 10 is amended, and claims 1-6 are amended. Accordingly, no new matter is presented in this Amendment.

#### **Objections to the Specification**

The abstract of the disclosure is objected to because the absolute value of the expression  $DT(V)-DT(0)$  is incorrectly represented. Applicants amend the abstract to obviate the objection. The abstract is further amended to more clearly describe the claimed subject matter and place the application in better compliance with commonly accepted US patent practice.

In addition, FIG. 10, step 205 is amended to depict wherein  $|DT(v)-DT(0)|$  is tested as being equal to  $C(V)$ , so as to agree with the specification. Withdrawal of the objection to the specification is respectfully requested.

#### **Objections to the Claims**

Claim 1 stands objected to because the absolute value of the expression  $DT(V)-DT(0)$  is incorrectly represented. Applicants amend claim 1, deleting the expression to obviate the objection. Withdrawal of the objection to claim 1 is respectfully requested.

#### **Claim Rejections under 35 USC 101**

Claims 1-6 stand rejected under 35 U.S.C. §101, as being directed to non-statutory subject matter. The Examiner alleges in the last four lines of the first paragraph in page 4 of the instant Office Action the "[t]he current claims appear abstract and do not appear to claim a tangible concrete result." Based upon the amendments to claim 1, this

rejection is respectfully traversed and the amended claims believed to be directed to statutory subject matter for the reasons discussed below.

Applicants respectfully submit that the Federal Circuit appears to abandon the State Street's "useful, concrete and tangible result" test (see *In re Bilski* (545 F.3d 943, 88 U.S.P.Q.2d 1385 (CAFC 2008) quoting *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368 (Fed. Cir. 1998)). The Federal Circuit indicates that the new test of patentability is whether the claimed method is: (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. Applicants respectfully submit that as amended, the amended claims meet at least the second test of patentability.

In *Bilski*, the Federal circuit reaffirmed that transformation of data that represented a physical object is patentable subject matter, ( "... we held one of *Abele*'s dependent claims to be drawn to patent-eligible subject matter," (see *Abele*, 684 F.2d at 908-09)). *Abele* recited X-ray attenuation data produced in a two dimensional field by a computed tomography scanner, and the Court stated that the data in *Abele* "clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible."

The Court further noted that "the electronic transformation of the data itself into a visual depiction in *Abele* was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented...So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle."

Applicants respectfully submit that amended claim 1 recites a method for locating difficult access points from a reference point on a topological map, and as amended, performs the required transformation. Support for the amendments to claim 1 is found

in at least page 13, line 16- page 15, line 11, and page16, line 30 – page 17, line 23.

Similar to *Abele*, the data being transformed in claim 1 is based upon points on a map, e.g., mountain peaks. The representation of a point on a map is transformed so to indicate difficulty in accessing that point. Based upon the recited method that transforms a representation of a point on a map to a second representation that indicates a difficulty of access, Applicants submit that the claimed subject matter is patentable under the transformation test requirement of 35 USC 101.

Accordingly, withdrawal of the rejection under 35 USC 101 is respectfully requested.

#### **Claim Rejections under 35 USC 112**

Claims 1 and 2 stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner alleges that the feature of “the Euclidean distances” has insufficient antecedent basis and suggest that the clause that includes this phrase be clarified to more clearly distinguish the recited feature. Accordingly, claim 1 is amended to more clearly recite the claimed subject matter. Withdrawal of the rejection is respectfully requested.

**Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the application is in condition for allowance and a Notice to that effect is earnestly solicited.

The Examiner is invited to telephone the undersigned, Applicants' attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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